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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

14215RRUS03U / 22171.299

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Signature

Typed or printed name

Debbie Ludwig

Application Number

10/028,086

Filed

December 21, 2001

First Named Inventor

Denman et al.

Art Unit

2151

Examiner

Phillips, Hassan A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐

attorney or agent of record.

Registration number _____

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 31,213

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July 21, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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*Total of 1 forms are submitted.

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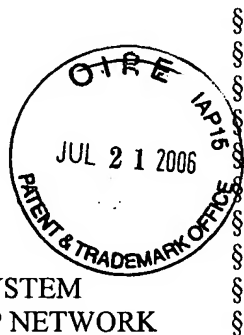
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Denman et al.

Serial No.: 10/028,086

Filed: December 21, 2001

For: PUSH-TO-TALK
TELECOMMUNICATIONS SYSTEM
UTILIZING A VOICE-OVER-IP NETWORK



Confirmation No. 1095

Group Art Unit: 2151

Examiner: Phillips, Hassan A.

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**REASONS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

I. BACKGROUND

The present paper is being filed under the Official Gazette Notice of July 12, 2005 and in response to the final Office action mailed March 23, 2006.

A Notice of Appeal and a Request for a One-Month Extension of Time, each with the proper fee, are being filed concurrently with this paper. It is assumed that no additional fees are required, but if any additional fees are required, the Commissioner is hereby authorized to charge any fees, including those for an extension of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

II. REASONS

In the final Office action mailed March 3, 2006, claims 1-36 were pending and under consideration. Claims 1-36 were rejected.

Independent claims 1 and 5 and dependent claim 17 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,477,150 to Maggenti et al. ("Maggenti"). Independent claims 26 and 36 stand rejected under 35 U.S.C. §103 as being unpatentable over Maggenti. It is respectfully submitted that there are clear errors with the Examiner's rejection of the claims. More specifically, and as described below, the grounds for rejection are clearly legally deficient because the asserted prior art lacks essential elements needed to establish a prima facie rejection with respect to each claim.

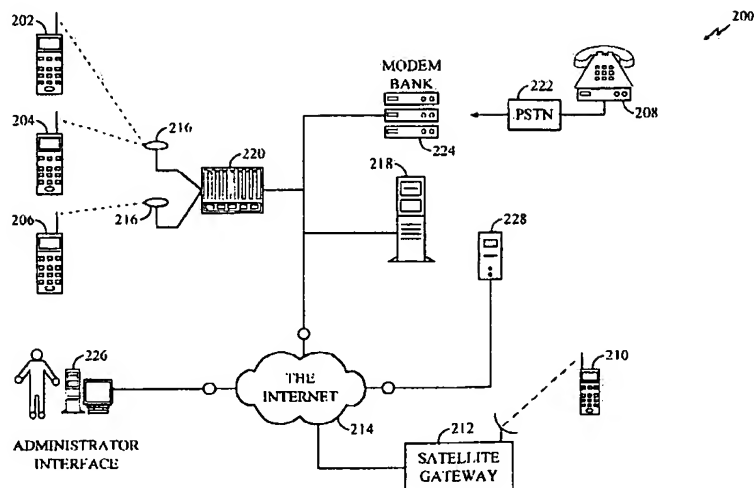
A. Claims 1, 5, and 17

The PTO specifies in MPEP §2131 that, to anticipate a claim, a reference must teach each and every element recited in the claim. The primary reference relied upon by the Examiner, U.S. Pat. No. 6,477,150 to Maggenti et al., fails to disclose the recited claim elements.

1. "an Internet Protocol (IP) network interconnecting the SIP Proxy server, the SIP Registrar and Location Server, and the PTT Server"

A first clear error is that the limitation of "an Internet Protocol (IP) network interconnecting the SIP Proxy server, the SIP Registrar and Location Server, and the PTT Server" (independent claim 1) is missing from Maggenti.

In numbered paragraph 15 of the final Office action mailed March 23, 2006, the Examiner takes the position that Maggenti's CM 218 anticipates each of the SIP Proxy server, the SIP Registrar and Location Server, and the PTT Server elements recited in claim 1. Assuming *arguendo* that the Examiner's position is correct, then clearly, as illustrated below in the reproduction of Fig. 2 of Maggenti, while Maggenti teaches an IP network connected to those three elements, by virtue of the fact that the CM 218 is connected to the Internet 214, Maggenti fails to teach an IP network interconnecting (i.e., connecting one to another) those three elements.



Therefore, for this independent reason, claim 1, as well as claims 2-4 dependent therefrom, are not anticipated by Maggenti.

2. “registering a contact for the user for media transmissions to other users in the group; wherein the contact for the user is the PTT server”

A second clear error is that the limitation of “registering a contact for the user for media transmissions to other users in the group; wherein the contact for the user is the PTT server” (independent claim 5) is missing from Maggenti. The Examiner has focused his argument that Maggenti anticipates this element on Maggenti’s teaching, at column 10, lines 46-55, of a method by which Maggenti enables a communication device (“CD”) to join a net, or group. The Examiner’s position as set forth in numbered paragraph 9 of the final Office action is that “[i]t is inherent in the cited passage that the PTT server is the contact for the user because a user will initially know or be able to learn the group address of any group it swishes to participate in from the PTT server” is clearly incorrect , as Maggenti provides no basis for the Examiner’s assumption that the PTT server is the contact for the user; rather, that basis is provided by Applicants’ specification and claims. Therefore, contrary to the Examiner’s assertions, Maggenti does not anticipate the subject limitation. For this independent reason, claim 5, as well as claims 6-14 dependent therefrom, are not anticipated by Maggenti.

3. “wherein the multicasting includes use of network address and port translation by the PTT server, whereby the PTT server replaces a destination IP address of a port number of received speech packets with an IP address of a port number of each target user and unicasts modified packets to each target user”

A third clear error is that the limitation of “wherein the multicasting includes use of network address and port translation by the PTT server, whereby the PTT server replaces a destination IP address

of a port number of received speech packets with an IP address of a port number of each target user and unicasts modified packets to each target user” (dependent claim 17) is missing from Maggenti. The Examiner has focused his argument that Maggenti anticipates this element on Maggenti’s teaching, at column 6, line 62, through column 7, line 7. Applicant respectfully submits that the cited portion, which describes granting the transmission privilege to a requesting net member and enabling that net member to transmit information to other net members via the CM, is totally devoid of any teaching or suggestion of, and is in fact, completely unrelated to, the subject element; the portion merely states that, after receiving the information from the member granted the privilege, the CM “provides the information to the net members by duplicating the information and sending each duplicate to the net members.” There is no further discussion as to how this is accomplished.

Therefore, contrary to the Examiner’s assertions, Maggenti does not anticipate the subject limitation. For this independent reason, claim 17 is not anticipated by Maggenti.

B. Claims 26 and 36

The PTO specifies in MPEP §2142 that, to establish a *prima facie* case of obviousness, the Examiner bears the burden of meeting three basic criteria:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations.

Accordingly, it is incumbent upon the Examiner in the first instance to factually support a conclusion of obviousness of the claims as a whole.

1. “redirecting the SIP SUBSCRIBE to a PTT Server for purposes of removing the calling party and the called party from a multicast group”

A fourth clear error is that the limitation of “redirecting the SIP SUBSCRIBE to a PTT Server for purposes of removing the calling party and the called party from a multicast group” (independent claims 26 and 36) is not met by Maggenti. The Examiner’s argument that that this element is obvious in view of Maggenti anticipates this element is summarized in numbered paragraph 11 of the aforementioned final Office action. In particular, the Examiner states that “if not implicit in the teachings of Maggenti, it would have been obvious . . . to modify the teachings of Maggenti to show redirecting an SIP SUBSCRIBE to the PTT server for purposes [of] removing the calling party and the called party from a multicast group.” The Examiner’s statement that column 6, line 62, through column 7, line 7; column 20, lines 26-30; and column 25, lines 51-57, of Maggenti suggest a means for redirecting a SIP

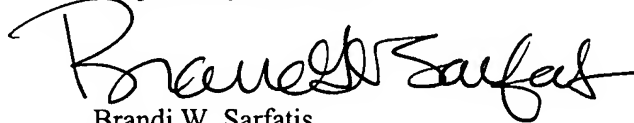
SUBSCRIBE to the PTT server for any purpose, much less for the specific purposes recited in claims 26 and 36 is clearly incorrect. Maggenti is totally devoid of any teaching or suggestion of "redirecting an SIP SUBSCRIBE".

Therefore, contrary to the Examiner's assertions, Maggenti does not render the subject limitation obvious. For this independent reason, claims 26 and 36, as well as claims 27-34 dependent from claim 26, are not unpatentable over Maggenti.

III. CONCLUSION

Applicants have therefore demonstrated four clear legal deficiencies in the Examiner's position. Consequently, the rejections are clearly not proper and are without basis and it is therefore respectfully requested that the rejections be withdrawn.

Respectfully submitted,



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Debbie Ludwig

